

remarks finding all claims allowable. Thank you.

2) Another Information Disclosure Statement and \$180.00 fee payment are included herewith. On 05/10/2004 an Information Disclosure Statement (IDS) was filed at the PTO to supplement the earlier filed Information Disclosure Statements of 12/05/2003 and 04/22/2004. The current Office Action does not indicate the 05/10/2004 IDS was reviewed by the Examiner. The PTO Public PAIR in the "Transaction History" section shows the 05/10/2004 IDS was received by the PTO, however the PAIR "Image File Wrapper" section does not show the 05/10/2004 IDS, which is probably why the Examiner did not show it had been reviewed.

Another IDS, basically a copy of the 05/10/2004 IDS with a some additional references, is herewith included for the Examiner to review during reexamination of the application.

The fee payment of \$180.00 for having the IDS considered is attached.

3) On June 18, 2003 (06/18/2003) by Preliminary Amendment the application priority claim under 35 USC 120 was amended on pages 5 and 6 of the Amendment.

Question: Was this priority claim amendment noted by the Examiner, and does Applicant need to do anything else to make sure the amended priority claim is that which is in effect and which will be typed on the first page of the patent to issue from this application?

4) It is noted claims 1-230 are pending in the application, that Group XIII was elected by Applicant, and that claims 193-194, 204-205 and 221-230 which are all of the pending

claims in Group XIII have all been initially rejected under 35 USC 103(a).

5) Careful reconsideration of claims 193-194, 204-205 and 221-230 is very respectfully requested in view of the following remarks believed to show the allowability of each of the claims.

6) On page 2 bridging page 3 at point "3" of the Office Action (OA) the Examiner rejects claims 193-194 under 35 USC 103(a) over Wislocki US 4933670 in view of Satoshi JP 9213168, Inoue US 5207426 and Poulson DE 4013227. The Examiner then recites elements of the claimed invention found in the relied upon references, provides a reasoning in the Examiner's opinion as to why such elements would be selected by one skilled in the art, concludes one of ordinary skill would select the various elements, some elements from each of the **four** references and would then combine the elements **precisely** as claimed without using "inventive" skill and without any knowledge whatsoever of Applicant's disclosure. Applicant very respectfully disagrees that one skilled in the art would find it obvious to combine the four relied upon references. The references do not guide, at least Applicant cannot find such guidance, one skilled in the art to pick elements from four references and combine them in a **precise** manner as needed to simulate the claimed invention. The Examiner has not pointed to any such guidance in the references, but rather has speculated on what one skilled in the art might do. Withdrawal of the rejection and allowance of the claims is therefore respectfully requested.

Furthermore withdrawal of the rejection of claim 193-194 is requested because contrary to MPEP 2143 the rejection does not:

point to any "suggestion or motivation" located in the relied upon references and

secondly does not point to "the reasonable expectation of success" and the location thereof in the relied upon references to lead one skilled in the art to make such a picking, choosing and recombining as suggested by the Examiner to simulate the claimed invention.

Additionally required by MPEP 2143 is a third requirement for establishing prima facie obviousness which is: when properly combined the references must teach or suggest "all" of the claim limitations. Here in the case of claims 193-194 (paraphrased) a single first button is positioned to actuate a first sensor and also actuated a second sensor; the first sensor being a proportional sensor and the second sensor is a switch capable of indicating an On state. Such limitations of claim 193 **not** being addressed in the rejection. Claim 194 further adds the element that at least one of the first or second sensors activates or when activated provides a turn-on tactile feedback which is also **not** addressed in the rejection. The turn-on tactile feedback is a separate and distinct feedback from the tactile feedback motor, and is for example only, a snap-through feedback such as from a collapsible dome well described in the specification.

Therefore prima facie obviousness has not been established. Applicant respectfully requests withdrawal of the rejection and allowance of claims 193-194.

7) On page 3 bridging page 4 at point "4" of the Office Action (OA) the Examiner rejects claims 204-205 and 221 under 35 USC 103(a) over Wislocki US 4933670 in view of Satoshi JP 9213168 and Poulson DE 4013227. The Examiner then recites elements of the claimed invention also found in the relied upon references, provides a reasoning in the Examiner's opinion as to why such elements would be selected by one skilled in the art, concludes one of ordinary skill would select the various elements, some elements from each of the **three** references and would then combine the elements **precisely** as claimed without using "inventive" skill and without any knowledge whatsoever of Applicant's disclosure. Again, Applicant very respectfully disagrees with the Examiner's conclusions. The references do not guide, at least Applicant cannot find such guidance, one skilled in the art to pick elements from three different references and combine them in a **precise** manner as needed to simulate the claimed invention. Withdrawal of the rejection and allowance of the claims is therefore respectfully requested.

Furthermore withdrawal of the rejection of claims 204-205 and 221 is requested because contrary to MPEP 2143 the rejection does not:

firstly point to any "suggestion or motivation" located in the relied upon references and

secondly does not point to "the reasonable expectation of success" and the location thereof in the relied upon references to lead one skilled in the art to make such a picking, choosing and recombining as suggested by the Examiner to simulate the claimed invention.

Additionally required by MPEP 2143 is a third requirement for establishing prima facie obviousness which is: when properly combined the references must teach or

suggest “all” of the claim limitations. Here in the case of claims 204-205 “a plurality of said sensors each including spacing isolating the plurality of sensors against being activated by vibration from said active tactile feedback” is not at all addressed by the rejection. Additionally the button of claim 204 said to actuate a proportional sensor also actuates a On/Off indicating sensor in dependent claim 205, a button actuating a proportional sensor and an On/Off sensor is not addressed in the rejection and thus claim 205 is also allowable.

Therefore prima facie obviousness has not been established and Applicant requests withdrawal of the rejection and allowance of the claims 204-205 and 221.

More specifically regarding claim 221 the claimed combination of elements is clearly highly novel and provides greatly enhanced control over games and three-dimensional imagery due to the variety of useful elements in combination. Such controllers are now in wide use around the world.

8) On page 4 bridging page 5 at point “5” of the Office Action (OA) the Examiner rejects claims 222, 224-226, 228 and 230 under 35 USC 103(a) over King US 4555960 and Poulos DE 4013227. The Examiner then recites elements of the claimed invention found in the relied upon references, provides a reasoning in the Examiner’s opinion as to why such elements would be selected by one skilled in the art, i.e, an advantage to be gained, and then concludes one of ordinary skill would select the various elements, some elements from each of the references and then combine the elements **precisely** as claimed without using “inventive” skill and without any knowledge of

Applicant's disclosure. Applicant very respectfully disagrees that such guidance is provided by the relied upon references.

The Examiner on page 5 in point 5 states that the number of sensors used in a controller with a rotating member and a three-axes member is a matter of obvious design choice, however Applicant respectfully disagrees with this conclusion regarding elements in claims 222-230 as obvious design choices. Applicant's 35 USC 120 priority claim includes a claim to the application 07/847,619 filed in 1992 by Applicant, now US Patent 5,589,828, which details the unexpected results and benefits of the arrangement of at least 12 sensors in a three-dimensional image controller. "Some" of the benefits described in Patent 5,589,828 include simplicity, economics, ease in identifying which sensor is triggered, eliminating sensor cross-talk and ability to add sensor isolation against false triggering by the vibration motor.

Furthermore withdrawal of the rejection of claims 222, 224-226, 228 and 230 is requested because contrary to MPEP 2143 the rejection does not:

Firstly point to any "suggestion or motivation" located in the relied upon references and

secondly does not point to "the reasonable expectation of success" and the location thereof in the relied upon references to lead one skilled in the art to make such a picking, choosing and recombining as suggested by the Examiner to precisely simulate the claimed invention.

Therefore prima facie obviousness has not been established and Applicant requests withdrawal of the rejection and allowance of the claims 222, 224-226, 228 and 230.

More specifically regarding claims 222, 224-226, 228 and 230 the claimed combination of elements is clearly novel and provides greatly enhanced control over games and three-dimensional imagery compared to controllers previously disclosed at the PTO earlier. Such advancement in three-dimensional controllers is needed and such controllers are now in wide use.

9) On page 5 at point "6" of the Office Action (OA) the Examiner rejects claims 223, 227 and 229 under 35 USC 103(a) over King US 4555960, Poulson DE 4013227 and Asher US 5689285. The Examiner then recites elements of the claimed invention also found in each of the relied upon references, provides a reasoning in the Examiner's opinion as to why such elements would be selected by one skilled in the art, i.e, an advantage to be gained, and then concludes one of ordinary skill would select the various elements, some elements from each of the three references and then combine the elements **precisely** as claimed without using "inventive" skill and without any knowledge of Applicant's disclosure. Applicant very respectfully disagrees that such guidance is provided by the three relied upon references. Claims 223, 227, 229 each add that at least some of the at least 12 sensors are pressure-sensitive type sensors, these dependent claims thereby further distinguishing the claimed invention from the prior art.

The Examiner states on page 5 in point 6 it would be obvious to use the sensors of Asher because the sensors "are a lot smaller", however Applicant very respectfully disagrees in that the pressure-sensitive sensors of claims 223,227 and 229 would be used in Applicant's invention even if larger or the same size as typical sensors in that they provide a major increase in functionality in the novel combination of the vibrator and

three-axes member with rotating member. The novel combination of the vibrator and three-axes member with rotating member with some of the sensors being variable pressure sensors is not suggested in and by the relied upon references, and such provides greatly enhanced control of three-dimensional imagery.

Furthermore withdrawal of the rejection of claims 223, 227 and 229 is requested because contrary to MPEP 2143 the rejection does not:

firstly point to any "suggestion or motivation" located in the relied upon references and secondly does not point to "the reasonable expectation of success" and the location thereof in the relied upon references to lead one skilled in the art to make such a picking, choosing and **precise** recombining as suggested by the Examiner to simulate the claimed invention. Therefore prima facie obviousness has not been established and Applicant requests withdrawal of the rejection with allowance of the claims 223, 227 and 229.

More specifically regarding claims 223, 227 and 229 the claimed combination of elements is clearly novel and provides greatly enhanced control over games and three-dimensional imagery compared to controllers previously disclosed at the PTO earlier. Such advancement in three-dimensional controllers is needed and such controllers are now in wide use.

The rejection of all of the claims in the current Office Action, in Applicant's opinion, is based upon the hindsight use of Applicant's disclosure and claims as a guide or blue print in selecting elements in the prior art, a situation wherein the Inventor's Invention is being used against him. The Inventor's invention is **not** prior art and thus cannot serve as

a guide to assemble elements or to combine references. The Examiner must necessarily have knowledge of the claimed invention, but that knowledge **cannot** be the basis for combining references and picking and choosing elements to simulate the claimed invention. The use of such hindsight knowledge as a guide is clearly improper and unfair because it treats the Inventor's invention as though it is prior art, which it is not.

Please Note MPEP 2143:

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."

Although proper in theory, it would be almost impossible to show in **four** different references as in point 3 of the O.A. that each reference should contribute only the selected element(s) to the selected element(s) of the other three references, and that those selected elements should be combined **precisely** as claimed by Applicant, and all of this without any knowledge of Applicants disclosure whatsoever. In the present case the four references do not suggest such a complex combination of elements as in claims 193-194, nor do the three references of point 4 suggest claims 204-205 and 221, nor do the two references suggest the claims rejected at point 5 nor the three references of point 6 suggest the claims 223, 227 and 229.

Please note in the MPEP at 2143 as above quoted that the authority cited by the Commissioner for Patents is "In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." The "Fed.Cir" is the United States Court of Appeals for the Federal Circuit established in the 1982 to, among other duties, oversee the U.S. Patent and Trademark Office.

The Patent Office is required to and wishes to follow the laws of the United States, and to follow the laws as defined by the United States Court of Appeals for the Federal Circuit unless contrary to the U.S. Supreme Court.

In re Dembiczak (Fed. Cir. 1999) the United States Court of Appeals for the Federal Circuit reversed the PTO Examiner and the Patent Office Board of Appeals in a patent application rejected on obviousness grounds stating:

*"...Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." "For it is this phrase that guards against entry into the tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section." "Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided **only** by the prior art references and the then-accepted wisdom in the field." "Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a **showing** of the teaching or motivation to combine prior art references." "the Board must **identify** specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them" "examiner can satisfy burden of obviousness in light of combination only by **showing** some **objective** teaching leading to the combination" "strict observance" of factual predicates to obviousness conclusion required". "Combining prior art references without **evidence** of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." (The above underlining and bolding by Applicant for emphasis)*

In the present Office Action of 02/22/2005, the Examiner has not pointed to any "**objective** teaching leading to the combination" of references, but instead has apparently used the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, an improper yet common basis for claim rejection due to "the insidious effect of a hindsight syndrome".

In RE MARY E. ZURKO decided Aug, 2, 2001, the United States Court of Appeals for the Federal Circuit again reversed the PTO Examiner and the Patent Office Board of Appeals in a patent application rejected on obviousness grounds stating:

*"We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, **the Board must point to some concrete evidence in the record in support of these findings.**"*

In the present case, the Examiner has not pointed to any "**concrete evidence**" in the record supporting the combination of the relied upon references.

The PTO wishes to follow the guidance of the United States Court of Appeals for the Federal Circuit in deciding the patentability of claims. Please see the following cases from the Board of Patent Appeals and Interferences where U.S. Patent Examiners were reversed on rejections based on obviousness similar to the present rejection wherein the suggestion or motivation to combine references lacked **substantial** or **concrete evidence** pointed to by the Examiner.

Appeal No. 2004-1223 copy of opinion provided. Please see pages 9-11 at least.

Appeal No. 2003-2018 copy of opinion provided. Please see pages 4, 6-7 at least.

Appeal No. 2001-0326 copy of opinion provided. Please see pages 6-8 at least.

Appeal No. 1999-2115 copy of opinion provided. Please see pages 4, 7 at least.

Appeal No. 2001-1008 copy of opinion provided. Please see pages 4-6 at least.

The above five listed opinions from the Board of Patent Appeals and Interferences are herein incorporated by reference in their entirety at this location in Remarks.

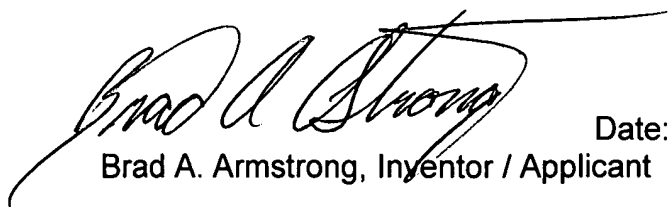
As clearly shown in the opinions of Board of Patent Appeals the PTO wishes to follow the guidance of the United States Court of Appeals for the Federal Circuit in deciding the patentability of claims. Additionally shown is that rejections based on obviousness must be supported by **substantial** or **concrete evidence** pointed to by the Examiner and made of record as **objective** evidence. Additionally shown is that the burden of establishing prima facie obviousness is on the Examiner and does not shift away, such as to Applicant, until a proper prima facie case has been made based on **substantial or concrete evidence**. Further shown herein is that prima facie obviousness cannot be established without "**all**" elements of a claim being taught or suggested in the relied upon references, this requirement not met in many of the current claims.

No prima facie case for obviousness has been made against any of the pending claims, thus for at least the reasons set forth herein, please find all claims allowable upon reexamination of the present application, claims and prior art. Thank you.

The Examiner is invited to please telephone Applicant regarding any matter which Applicant may be of assistance. Thank you.

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Very Respectfully,


Brad A. Armstrong, Inventor / Applicant

Date:

May 19, 2005